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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/898,621      | 07/03/2001  | Stephen Weinhold     | 71363               | 2318             |

7590 01/15/2004

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EXAMINER

WYROZEBSKI LEE, KATARZYNA I

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 01/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/898,621

Applicant(s)

WEINHOLD ET AL.

Examiner

Katarzyna Wyrozebski Lee

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

In view of amendment mailed on 10/14/2003 following final office action has been necessitated.

Applicant's arguments as submitted in the amendment mailed on 10/14/2003 do not overcome the prior art of record. Rejections as stated in the first office action on the merits mailed on 08/01/2003 are incorporated here by reference.

*Claim Rejections - 35 USC § 103*

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-8, 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu (US 5,925,710).

The discussion of the disclosure of the prior art of WO from paragraph 6 of the office action mailed on 8/1/2003 is incorporated here by reference.

3. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over WU (US 5,925,710) as applied to claims 1-8, 16-20 above, and further in view of Tindale (US 5,419,936).

The discussion of the disclosure of the prior art of WU and TINDALE from paragraph 7 of the office action mailed on 8/1/2003 is incorporated here by reference.

4. Claims 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over WU (US 5,925,710) or WU (US 5,925,710) in view of Tindale (US 5,419,936) as applied to claims 1-8, 16-20 above, either one of which further in view of Pruett (US 4,617,374).

The discussion of the disclosure of the prior art of WU, TINDALE and PRUETT from paragraph 8 of the office action mailed on 8/1/2003 is incorporated here by reference.

5. In the response to mailed on 10/14/2003 the applicants argued following issues:

a) The prior art of WU teaches polyester comprising at least 65 mole % of ethylene glycol, which would mean that remaining 35 mole percent can be either CHDM, DEG or mixture of the two.

With respect to the above argument the examiner would like to draw applicants attention to term "at least 65 mole %" when describing the amount of EG. Term at least means that the amount of EG can be as little as 65 % and also as much as 95 %. In fact in the rejection mailed on 8/1/2003 the examiner referred to the example, which utilized 95 mole % of EG, 1.4 mole% of DEG and the remaining balance (to add up to 100 %) would belong to the second preferred monomer in the mixture, CHDM (that would be 3.6 mole %) all of which lie squarely in the middle of the amount ranges of the present invention.

b) With respect to the inherent viscosity (IV) the examiner is using hindsight reconstruction to derive at present invention.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so

long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In the rejection the examiner clearly explained why such inherent viscosity would have been obvious to one having ordinary skill in the art. To make the same article such as container or beverage bottle certain conditions in viscosity have to be satisfied as the polyester compound would be subjected to treatment such as extrusion and melt blending. Such would have been further supported by the fact that the blow molding temperature and reheat temperatures of the polyester of WU is within the same range as the temperatures recited by the claims of the present invention. If stretched below 100°C would affect physical properties of the article (col. 8, lines 23-26). The melt temperatures of glass transition temperatures are proportional to molecular weight of the polymer as well as its composition (monomers types and amounts).

c) The prior art of WU does not provide guidance as to what or how much of the modifying diols should be utilized.

In addition to the arguments above where the amounts of diols are specifically defined, the examiner would like to again point the applicants to following:

Col. 4, lines 38-42 where WU discloses that preferred modifying diols are CHDM and DEG or mixture thereof.

Example 7 discloses 95 mole % of EG, 1.4 mole% of DEG, wherein remaining 3.8 mole % obviously would belong to the second preferred modifying diol, CHDM. The total amount of diol components has to add up to 100.

d) The polyester of TINDALE does not satisfy the claims of the present invention.

With respect to the above argument, the prior art of TINDALE was a secondary prior art, which was utilized to supply re-heat aids, which were taught by the prior art of WU as is. It was not utilized for its recitation of polyester components. It is examiner's position that applicants although addressed the prior art of TINDALE did not specify as to why it would not have been obvious to utilize re-heating aids of TINDALE in the composition of WU.

e) One of ordinary skill in the art would not be motivated to modify the prior art of WU or WU in view of TINDALE with the disclosure of PRUETT.

With respect to the above argument, polycondensation polymers when not protected by UV absorbing compounds pass significant portions of the UV wavelength through the clear plastics and this would be the case in any clear beverage container. Utilizing compounds that absorb UV radiation would be a common sense to one having ordinary skill in the art.

In addition, Selection of a known material based on its suitability for its intended use supports *prima facie* obviousness. *Sinclair & Carroll Co vs. Interchemical Corp.* 325 U.S. 327, 65 USPQ 297 (1945). Also, the combination of two compositions, each of which is taught by the prior art to be useful for the same purpose, in order to for a third composition that is to be used

for the very same purpose may be prima facie obvious. *In re Susi*, 440 F.2d 442, 445, 169 USPQ 423, 426 (CCPA 1971). In the instant case, both prior art disclosures teach polyester bottles.

f) The polyester of the prior art of PRUETT does not satisfy the polyester of the present invention.

With respect to the above argument, the prior art of PRUETT was utilized to provide for the UV compound and not for the specific polyester.

g) In the summary the applicants state that it would have not been obvious to combine the prior art as disclosed in first office action on the merits and arrive at the present invention.

It is examiner's position, that this question has already been addressed while answering to single individual arguments as presented in applicant's response.

**6. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

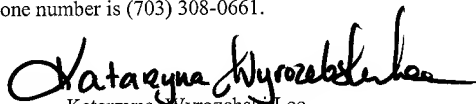
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski Lee whose telephone number is (571) 272-1127. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Katarzyna Wyrozebski Lee  
Primary Examiner  
Art Unit 1714

kiwl  
January 13, 2004